

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

ASHTON et al.

Atty. Ref.: 620-401; Confirmation No. 1869

Appl. No. 10/556,901

TC/A.U. 1625

Filed: November 15, 2005

Examiner: Chandrakumar

For: GLYOXALASE INHIBITORS

* * * * *

December 18, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**PETITION FOR COMPLETE OFFICE ACTION WITH DATE RE-SET FOR RESPONSE
FROM MAILING OF NEW COMPLETE ACTION**

A complete Action in place of the Office Action dated November 19, 2008, with the date re-set for responding from the mail date of the new Action is requested as the Office Action of November 19, 2008 is incomplete in that the Examiner's definitions of the subject matter of the Examiner's Groups 1 and 2 are the same (i.e., "Group 1 ...drawn to compounds that do not have heterocyclic moieties. Group 2, ... drawn to compounds that do not contain heterocyclic moieties.>"). There is no patentable distinction between the subject matter defining the Examiner's Groups 1 and 2 of the Office Action dated November 19, 2008.

Moreover, the Examiner has cited "(CAS Number 108-98-5)"¹ in support of the restriction requirement without providing a copy of the document or listing the document on a PTO 892 Form.

The applicants note that Rule 104 provides the following requirement for completeness of Office Actions (underlined emphasis added):

(a) Examiner's action.

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution. ...

(b) Completeness of examiner's action. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

MPEP § 707 further provides the following:

¹ See page 3 of the Office Action dated November 19, 2008.

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In accordance with the patent statute, "Whenever, on examination, any claim for a patent is rejected, or any objection . . . made," notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given

Finally, MPEP § 707.07(g) provides the following:

707.07(g) Piecemeal Examination

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, how-ever, undue multiplication of references. (See MPEP § 904.03.)

A new complete Action is requested, with the date for responding being re-set from the mailing of the new Action, in the event the restriction requirement is maintained.

Withdrawal of the restriction requirement and further action on the merits of the claimed invention are requested for the reasons noted in the concurrently-filed Response.

Respectfully submitted,

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